

## **Remarks**

This is a complete response to the Office Action mailed August 21, 2006. The amendments and remarks are proper, do not introduce new matter, are not narrowing in view of a rejection over a cited reference, and place the application in proper condition for reconsideration and withdrawal of the restriction requirements and the rejections.

Absent the requested reconsideration, these remarks also explain why this case is not in condition for appeal.

## **Restriction Requirement**

Applicant respectfully requests reconsideration of the finality of the restriction requirement between the claims of groups I, II, and III.

In the absence of reconsideration, and if Applicant decides to continue prosecution of the restriction requirement, the basis of such a petition will be straightforward.

Applicant and the Examiner agree that in order to substantiate the restriction requirement the Examiner is obligated to show either how the process of claim 1 can be used to make a materially different product than claims 25 and/or 30, or how the product of claims 25 and/or 30 can be made by a materially different process than claim 1. (MPEP 806.05(f), see Office Action of 3/1/2006, pg. 2) The Examiner says he has met that obligation but cannot point specifically in the record where he did so, he just says that he did so in the Office Actions of 3/1/2006 and 8/22/2005 (Office Action of 8/21/2006, pg. 2).

In the Office Action of 8/22/2005 the Examiner's basis for maintaining the restriction requirement of groups I and II was that the method of claim 1 can consist of biasing without rotation. Applicant rebutted that argument by pointing out that the *placing prewritten*

*discs...disposing the angular reference axes symmetrically around the motor hub* does require rotation (Applicant's Response of 11/22/2005, ppg. 9-12). The Examiner did not refute or even address Applicant's rebuttal.

In the Office Action of 8/22/2005 the Examiner's basis for restricting groups I and III and groups II and III was his reading of claim 30 to mean the servo information was "on the motor" instead of "on the discs." Applicant traversed the Examiner's construction as unreasonable, but nevertheless amended claim 30 to more particularly point out and distinctly claim *stacking...discs with prewritten servo information ~~on~~ onto the motor*. The Examiner neither refuted nor addressed Applicant's rebuttal.

In the Office Action of 3/1/2006 the Examiner's basis for maintaining the restriction requirement was that group I claims are directed to a method and groups II and III are directed to an apparatus. Applicant rebutted the Examiner's basis because it wholly ignores the Examiner's obligation to show how the process of claim 1 can be used to make a materially different product, or how the products of claim 25 and 30 can be made by a materially different process. (MPEP 806.05(f)) The mere fact that some claims are directed to a method and other claims are directed to an apparatus is not, in and of itself, grounds for the restriction requirement. However, the Examiner neither refuted nor addressed Applicant's rebuttal.

Applicant again respectfully traverses the restriction requirements and requests reconsideration and withdrawal of them because the Examiner has not substantiated them in the record according to the requirements of MPEP 806.05(f).

## Rejection Under Section 102

Claims 1, 3, 5, 7, 9, and 21 stand rejected as being anticipated by Kuroba '990. This rejection is respectfully traversed in view of the clarifying amendment to claim 1 and the accompanying remarks.

### Claim 1

Applicant does not disagree with the Examiner's construction of the term "biasing" to the extent that it has the effect of balancing the disc stack. Although Kuroba '990 does not use the term "bias" or any form thereof, the effect of balancing the disc stack is consistent with the term's usage in the present specification with regard to the direction of the biasing force 140 (see, for example, FIG. 2 and paras. [0025] and [0032]).

However, Applicant expressly does not agree with the Examiner's construction of the phrase "common angular reference axis" as meaning "any axis along each disc used in biasing...." The Examiner's construction is unreasonably broad because it ignores the plain meaning of the term "common," thereby in effect ignoring claim language. *In re Morris*, 43 USPQ2d 1753 (Fed. Cir. 1997) The Examiner's position is untenable because he has not substantiated any credible argument in the record explaining how different discs in Kuroba '990 that are biased in different directions are reasonably seen as anticipating *placing prewritten discs, each characterized by servo tracks that are offset in relation to a common angular axis of each disc.*

The Examiner furthermore continues to ignore the fact that Kuroba '990 expressly discloses making a disc stack of discs that do not have servo tracks offset in relation to a common angular axis. In the very passage the Examiner relies on, Kuroba discloses:

If a plurality of disk media 20 are stacked, a balance control can be attained by the following manner. The position at

which the inner periphery of the disk medium comes into contact with the outer periphery of the spindle hub is changed alternately one by one at positions symmetrically with respect to the axis E of rotation. Otherwise, the contact position is changed by a certain angle, one after another, for the respective disks. However, in a case of the data surface servo system, the servo track writing (STW) must be performed individually for the groups of disks in which the contact position is changed for the respective groups. (Kuroba '990, col. 8 lines 38-41, emphasis added)

Here Kuroba '990 expressly discloses that a disc stack cannot be made of discs having *servo tracks that are offset in relation to a common angular axis of each disc* as in the present embodiments as claimed. Rather, in Kuroba '990 each respective group of discs (defined by biasing direction) must have servo track writing performed individually so that when placed angularly and biased the servo tracks of the discs will be concentric with respect to each other.

Having already rebutted, above, the Examiner's construction of "common angular axis" to effectively mean "any axis of each disc," Applicant also rebuts the Examiner's construction of the term "offset" as meaning the orthogonal angle of each servo track to the "any axis of each disc" as unreasonably broad because it ignores the plain meaning of the claim term consistent with its usage in the specification. *In re Morris*. Nevertheless, and solely in order to more particularly point out and distinctly claim the present embodiments to facilitate progress on the merits by avoiding appeal, Applicant has amended claim 1 to obviate the Examiner's concern by reciting *placing prewritten discs, each characterized by servo tracks that are offset concentrically in relation to a center of each disc and in relation to a common angular reference of each disc....*

Support for this amendment is found at least in FIG. 2 and the discussion thereof at least in paragraph [0024]. A common offset in concentricity of the servo tracks in relation to the disc center defines a common angular reference axis. That is, it will be noted in FIG. 2 that with

respect to the direction 140 of the biasing force, the distance from a servo track to the edge of the disc 108 adjacent the biasing force is less than the distance from the same servo track to the opposing edge of the disc 108. Applicant has included herewith a marked-up copy of the attachment earlier submitted in Applicant's Response filed 11/30/2004. It will be noted that in both attachments, this concentricity offset of the servo tracks is the same for both discs, but the servo tracks become concentrically aligned with respect to each other because the common angular references have been angularly rotated. Applicant is willing to include these explanatory attachments as drawing figures if the Examiner believes that would more clearly disclose the present embodiments as claimed.

Reconsideration and withdrawal of the present rejection of claim 1 and the claims depending therefrom are respectfully requested because the cited reference does not identically disclose all the recited features of the present embodiments.

Absent the requested reconsideration, a Pre-Brief Panel must find in the underlying facts "substantial evidence" that adequately supports the Examiner's legal conclusion of anticipation. This approach is consonant with the Office's obligation to develop an evidentiary basis for its factual findings to allow for judicial review under the substantial evidence standard that is both deferential and meaningful. *see In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

Only a travesty of inequities would require Applicant to proceed to appeal on a rejection based on mischaracterizations of what is claimed and what the cited reference discloses. Accordingly, this case is not in condition for appeal due to the unresolved factual issues that the Examiner has failed to make the requisite evidentiary showing in the record substantiating a prima facie case of anticipation, and due to the factual mischaracterizations of the cited

reference, and due to the legal mischaracterizations asserted in the flawed attempt at a prima facie case of anticipation.

### **Rejection Under Section 103**

Claims 6 and 8 stand rejected as being unpatentable over Kuroba '990 and over Kuroba '990 in view of JP '442, respectively. These rejections are traversed because these claims are allowable as depending from an allowable independent claim, for reasons above, and providing additional limitations thereto. Reconsideration and withdrawal of the present rejection of these claims are respectfully requested.

### **Allowable Subject Matter**

Applicant gratefully acknowledges the indication of allowability of claims 22-24. However, Applicant has opted not to place these claims in independent form because the independent claims from which they depend are allowable, for reasons above. These claims are therefore allowable as depending from an allowable independent claim and providing additional limitations thereto.

### **Conclusion**

This is a complete response to the Office Action mailed August 21, 2006. The Applicant has also filed herewith a Request for Telephone Interview with the Examiner and his supervisor at a time before the Examiner makes any action on the merits other than passage of all claims to issuance. The interview is necessary to clarify disputed issues where the incompleteness of this latest Office Action, the RCE requirement, and the finality of the restriction requirement have

unduly delayed the issuance of Applicant's valuable patent rights.

The Examiner is invited to contact the below signed Attorney should any questions arise concerning this response or the request for interview.

Respectfully submitted,

By: 

Mitchell K. McCarthy, Registration No. 38,794  
Randall K. McCarthy, Registration No. 39,297  
Fellers, Snider, Blankenship, Bailey and Tippens  
100 N. Broadway, Suite 1700  
Oklahoma City, Oklahoma 73102  
Telephone: (405) 232-0621  
Facsimile: (405) 232-9659  
Customer No. 33900

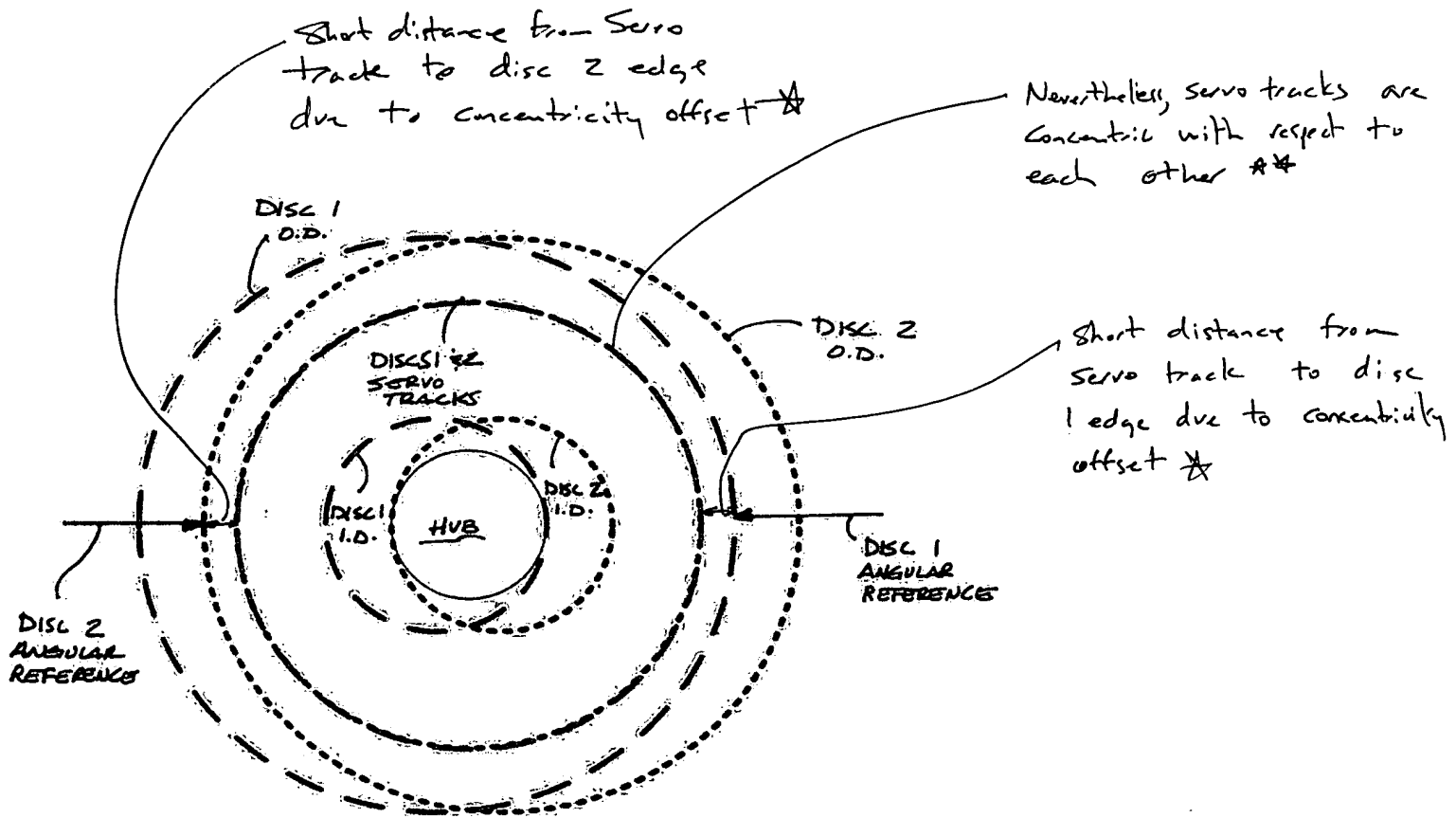


EXHIBIT A



